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By Deanna L. Shields
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: **John F. Thompson**

APPLICATION NO.: **09/967,107**

EXAMINER: **R.S. Landsman**

FILED: **9/28/2001**

ART UNIT: **1647**

FOR: **Assays for Determination of Functional Binding
of Compounds to Receptors**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE UNDER 37 CFR §1.111

Applicant hereby responds to the Office Action mailed October 16, 2003 in the subject patent application.

In response to the restriction requirement, Applicant provisionally elects the claims of Group I (i.e., claims 1-41) with traverse.

Applicant requests that the restriction requirement be reconsidered on the grounds that the Examiner has not shown that a serious burden would exist in examining all the claims. MPEP § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. §121); *and* (2) that the search and examination of the entire application cannot be made without serious burden. See MPEP §803.

The Examiner has not shown that the second requirement has been met. Specifically, the Examiner has not shown that it would be a serious burden to search and examine both Groups I and II together. The claims of Group I are directed to methods for determining functional binding of agents to receptors. The single claim of Group II is directed to pharmaceutical compositions of agents identified using the assays of the claims in Group I. The claim in Group II is defined by the same methods as are the claims in Group I.

Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested for all claims, but particularly with respect to the claims of Groups I and II.

Respectfully submitted,

Date: February 9, 2004



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